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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,031

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Naoya Watanabe

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10/28/2005

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EXAMINER

NGUYEN, PHUOC H

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,031

Applicant(s)

WATANABE, NAOYA

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on August 5, 2005. Previous office action contained claims 1-14. Applicant amended claims 1, 2, 4, 6-8, 10, 12, and 13. Amendment filed on August 5, 2005 have been entered and made of record. Therefore, pending claims 1-14 are presented for further consideration and examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 7, and 14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurlow (Hereafter, Thurlow) U.S. 5,917,489.

5. Regarding claims 1, 7, and 13-14, Thurlow discloses in Figures 1-9 a communication apparatus having a function of transmitting/receiving e-mail (e.g. abstract and Figure 2), comprising: storage means for storing plural kinds of communication partner information for

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each of a plurality of communication partners (e.g. Figure 4 with all the storage boxes); identifier detecting means for detecting a plurality of identifiers corresponding to the plural kinds of communication partner information from a received e-mail (e.g. Figures 5-6 as having detecting the rules); and specifying means for specifying when detecting means detects a predetermined identifier from among the plurality of identifiers, a communication partner information to be registered (e.g. cols. 11-12 according to the rules by wizard); and registering means for registering information associated with the identifiers detected by detecting means as communication partners information (e.g. 502 in Figure 4), of the specified communication partner information to storage means (e.g. Figure 4 with message store provider); wherein if a plurality of predetermined identifiers are detected in the received e-mail, specifying means specifies a communication partner information for each one of predetermined identifiers and registered means in turn registers information associated with the identifiers detected by detecting means (e.g. cols. 11-12 according to the created rules using wizard).

6. Regarding claims 2 and 8, Thurlow further discloses in Figures 1-9 predetermined identifier is not detected in the e-mail, registering means does not register any information even if an identifier other than predetermined identifier is detected.

7. Regarding claims 3 and 9, Thurlow further discloses in Figures 1-9 registration designating means by which a user designates registration by registering means, wherein registering means registers only information whose registration is designated by registration designating means (e.g. created by the rules seen in Figures 6).

8. Regarding claims 4 and 10, Thurlow further discloses in Figures 1-9 extracting means for extracting the communication partner information stored in storage means; and mail generating

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means for generating e-mail data having a body in which pieces of information constituting the extracted communication partner information are described in one-to-one correspondence with identifiers corresponding to registration items in which these pieces of information are registered (e.g. cols. 13-14).

9. Regarding claims 5 and 11, Thurlow further discloses in Figures 1-9 the information described in the e-mail in accordance with the detected identifier is described subsequently to the detected identifier (e.g. Figure 3).

10. Regarding claims 6 and 12, Thurlow further discloses in Figures 1-9 communication partner information includes the name and register at least one of, name reading, telephone number, and e-mail address of a communication partner (e.g. Figure 3).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lytle et al. U.S. Patent No. 6,912,950

Shouji U.S. Patent No. 6,912,519

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

October 25, 2005



PHUOC H. NGUYEN
EXAMINER